

REMARKS/ARGUMENTS

Upon entry of the present amendment, claims 1-19 will have been canceled and claims 20-29 will have been submitted for consideration by the Examiner. In view of the above, Applicant respectfully requests reconsideration and withdrawal of the outstanding objection and rejections of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided, for the acceptance of the drawings filed in the present application on June 27, 2000, and for the acknowledgment of Applicants' claims for priority under 35 U.S.C. §119 and receipt of the certified copies of the priority documents in the Official Action. Applicant also notes with appreciation Examiner's acknowledgment of Applicant's Information Disclosure Statement filed in the present application on August 15, 2000 by the return of the initialed and signed PTO-1449 Form, and for consideration of the documents cited in Information Disclosure Statement.

Turning to the merits of the action, the Examiner has objected to the abstract of the disclosure. In response to the Examiner's requirement, Applicant has provided a new Abstract of the Disclosure that does not exceed 150 words in length. Thus, Applicant respectfully requests that the Examiner withdraw this objection.

The Examiner has also objected to claims 11 and 12 under 37 C.F.R. 1.75 (c), as failing to further limit the subject matter of a previous claim. By the present amendment, Applicant has canceled claims 11 and 12 without prejudice or disclaimer. Thus, Applicant respectfully requests that this objection be withdrawn.

First, the Examiner has rejected claims 1, 15, and 17-19 under 35 U.S.C. § 102 (e), as being anticipated by MITANI (U.S. Patent No. 6,124,943). Second, the Examiner has also rejected claims 2-4 under 35 U.S.C. § 103 (a), as being unpatentable over MITANI (U.S. Patent No. 6,124,943) in view of SILVERBROOK (U.S. Patent No. 5,984,446). Third, the Examiner has rejected claim 5 under 35 U.S.C. § 103 (a), as being unpatentable over MITANI (U.S. Patent No. 6,124,943) in view of SILVERBROOK (U.S. Patent No. 5,984,446) and FUJIOKA (Japanese Laid-Open Publication No. Hei 11-301058). Fourth, the Examiner has rejected claims 6-8 under 35 U.S.C. § 103 (a), as being unpatentable over MITANI (U.S. Patent No. 6,124,943) in view of NAKATANI (U.S. Patent No. 5,854,692). Fifth, the Examiner has rejected claims 9-12 under 35 U.S.C. § 103 (a), as being unpatentable over MITANI (U.S. Patent No. 6,124,943) in view of SILVERBROOK (U.S. Patent No. 5,984,446) and ISHIBASHI (U.S. Patent No. 6,226,329). Sixth, the Examiner has rejected claim 13 under 35 U.S.C. § 102 (e), as being anticipated over MITANI (U.S. Patent No. 6,124,943) in view of MENENDEZ (U.S. Patent No. 5,113,494). Seventh, the Examiner has rejected claim 14 and 16 under 35 U.S.C. § 102 (e), as being anticipated over MITANI

(U.S. Patent No. 6,124,943) in view of FUJIOKA (Japanese Laid-Open Publication No. Hei 11-301058).

As noted above, Applicant has canceled the rejected claims and has submitted new claims 20-39. In this regard, Applicant notes that newly added claim 20 generally corresponds to original claims 1, 9, and 16, and that newly added claim 21 generally corresponds to original claim 13. Newly added claim 23 generally corresponds to original claim 10. Newly added claim 25 generally corresponds to original claim 6. Newly added claim 26 generally corresponds to original claim 7. Newly added claim 27 each generally corresponds to original claim 8. Newly added claim 28 generally corresponds to original claims 1, 5, 9, and 16. Newly added claim 29 generally corresponds to original claim 18. Claims 22 and 24 are newly submitted. In view of the herein-contained amendments and remarks, Applicant respectfully traverses the above rejection based on newly added claims 20-29 and will discuss said rejection with respect to the pending claims in the present application as will be set forth hereinbelow.

Applicant's claims 20-28 generally relate to a multifunction apparatus which has a facsimile communication section that conducts a facsimile communication. The claimed multifunction apparatus also includes an interface which receives PDL data from a host apparatus, and a controller which obtains image data based on the received PDL data. The claimed multifunction apparatus additionally includes a compressor which compresses the obtained image data by a

compression method utilized for the facsimile communication, and a memory which stores the compressed image data. Further, the controller predicts an amount of the image data compressed by the compression method utilized for the facsimile communication before storing the compressed image data in the memory, judges whether the predicted amount of the compressed image data can be stored in the memory, and stores the compressed image data in the memory when the predicted amount of the compressed image data can be stored in the memory. Claim 29 recites a generally related method.

To the contrary, MITANI relates to a printing apparatus in which an entire page is compressed to secure a vacant area sufficient enough to avoid deadlock (see, col. 6, lines 37-46 of MITANI). MITANI merely teaches determining whether the memory is deficient or not in consideration of whether an actual vacant memory size is sufficient, and whether the page compression process can be executed (see, col. 13, lines 1-9 of MITANI), and that if the memory is not determined to be deficient, bit map images are compressed by the designated compression and the compressed data is loaded in the RAM 250 (col. 13, lines 12-21 of MITANI). MITANI also teaches that if all the print-overrun bands cannot be held in the RAM 250, the page compression process is executed on the all bands.

However, MITANI does not disclose at least the claimed multifunction apparatus which has a facsimile communication section (see, Fig. 2 of MITANI, no facsimile function whatsoever is disclosed in Fig. 2), and which compresses

printed data by the compression method utilized for the facsimile communication. The multifunction apparatus of the present claimed invention has a facsimile communication section and utilizes the compression method utilized for the facsimile communication in receiving the PDL data from the host apparatus. Thus, MITANI does not disclose at least this feature of the pending claims.

While MITANI teaches that the present invention may be applicable to any of a single apparatus, a system made up of a plurality of apparatus, and a system in which data is processed through a network such as LAN, so long as it can execute the function to be achieved by the present invention (see, col.5, lines 35-38), this description does not change the disclosed invention of MITANI, since the feature of MITANI compresses the entire page to secure a vacant area sufficient enough to avoid the deadlock. Thus, MITANI does not disclose at least utilizing the compression method utilized for the facsimile communication in receiving the PDL data from the host apparatus.

Further, MITANI teaches that the data size after compression is calculated based on a compression rate estimated from the compression type (see, col. 17, lines 32-34 of MITANI). However, this explanation of MITANI is very general, and thus provide no enabling description of the features of the present claimed invention. However, in the present invention, an amount of data cannot be predicted based on PDL data, since PDL data has a plurality of layers. Thus, the present claimed invention obtains the image data based on PDL data and then

compresses the image data by the compression method utilized for the facsimile communication, since the multifunction apparatus of the present invention has a facsimile communication section. Therefore, the present claimed invention predicts an amount of the compressed data before storing the compressed data in the memory. In other words, the present invention predicts an amount of the compressed image data by the compression method utilized for the facsimile communication in receiving the PDL data from the host apparatus. Thus, MITANI does not disclose the above claimed features of the present invention, for at least the above reasons.

Therefore, it is respectfully submitted that the features recited in Applicant's claims 20-29 are not disclosed in MITANI.

Absent a disclosure in a single reference of each and every element recited in a claim, a *prima facie* case of anticipation can not be made under 35 U.S.C. § 102. Since the applied reference fails to disclose each and every element recited in independent claims 20, 28, and 29 (which respectively correspond to original independent claims 1 and 18) and the claims dependent therefrom, these claims are not anticipated thereby. Accordingly, the Examiner is respectfully requested to withdraw the rejection under 35 U.S.C. § 102.

With respect to the Examiner's rejection of the dependent claims 5, 9, and 16 under 35 U.S.C. § 103 (a), Applicant traverses hereinbelow, and notes that

these dependent claims, as described above, have been incorporated into at least one of new independent claims 20 and 28.

SILVERBROOK relates to a color office printer which uses drops on demand printing systems. However, SILVERBROOK does not disclose a facsimile communication section, since SILVERBROOK relates to a liquid ink printer. Thus, SILVERBROOK does not disclose at least using the compression method utilized for the facsimile communication in receiving the PDL data from the host apparatus. Further, SILVERBROOK does not disclose at least predicting an amount of the compressed image data by the compression method utilized for the facsimile communication in receiving the PDL data from the host apparatus, as claimed in claims 20, 28, and 29.

Therefore, it is respectfully submitted that the features recited in Applicant's independent claims 20 (generally based on original claims 1, 9, and 16), claim 28 (generally based on original claims 1, 5, 9, and 16), and claim 29 (generally based on original 18) are not disclosed in SILVERBROOK.

The combinations of the pending claims are clearly distinct from any proper combination of MITANI and SILVERBROOK, since neither MITANI nor SILVERBROOK discloses the above features recited in any of Applicant's claims. Thus, the pending claims are submitted to be patentable over the Examiner's proposed combination.

ISHIBASHI relates to an image storing and processing device which can be used as a skip-back camera, a railroad crossing monitor, and the like. However, ISHIBASHI does not disclose PDL data and a facsimile communication section, since ISHIBASHI relates to a skip-back camera, a railroad crossing monitor, and the like. Thus, ISHIBASHI does not disclose the compression method utilized for the facsimile communication in receiving the PDL data from the host apparatus, as claimed in claims 20, 28, and 29.

Therefore, it is respectfully submitted that the features recited in Applicant's independent claims 20 (generally based on original claims 1, 9, and 16), claim 28 (generally based on original claims 1, 5, 9, and 16), and claim 29 (generally based on original claim 18) are not disclosed in ISHIBASHI.

The combinations of the pending claims are clearly distinct from any proper combination of MITANI, SILVERBROOK, and ISHIBASHI, since MITANI, SILVERBROOK, and ISHIBASHI fail to disclose the above features recited in Applicant's claims. Thus, the pending claims are submitted to be patentable over the Examiner's proposed combination.

FUJIOKA relates to a storage printing system in which when a user instructs a storage printing at a host apparatus, a printer receives, from the host apparatus, data to which a password of the user is added. The printer stores the received data and the added password in a memory, and the printer prints the data stored in the memory when a password input by the user corresponds to the

password stored in the memory. However, FUJIOKA does not disclose at least using the compression method utilized for the facsimile communication in receiving the PDL data from the host apparatus, as claimed in claim 20, 28, and 29; FUJIOKA merely compresses data when the data is stored in the memory. In other words, FUJIOKA merely states that the data is compressed by a compression method (see, paragraph 0032 of FUJIOKA). Thus, FUJIOKA does not disclose using the compression method utilized for the facsimile communication in receiving the PDL data from the host apparatus.

Further, FUJIOKA does not disclose predicting an amount of the compressed image data; FUJIOKA merely checks whether the memory has enough area to store the data (see, paragraph 0039 of FUJIOKA). In other words, independent claims 20, 28, and 29 of the present invention predict an amount of the image data compressed by the compressor before storing the compressed image data in the memory, and then judge whether the predicted amount of the compressed image data can be stored in the memory. Thus, FUJIOKA does not disclose at least predicting an amount of the compressed image data by the a compression method utilized for the facsimile communication in receiving the PDL data from the host apparatus.

Therefore, it is respectfully submitted that the features recited in Applicant's independent claim 20 (generally based on original claim 1, 9, and 16),

claim 28 (generally based on original claims 1, 5, 9, and 16), and claim 29 (generally based on original claim 18) are not disclosed in ISHIBASHI.

The combinations of the pending claims are clearly distinct from any proper combination of MITANI and FUJIOKA, or from any proper combination of MITANI, SILVERBROOK, and FUJIOKA, since MITANI, SILVERBROOK, and FUJIOKA disclose the above features recited in Applicant's claims. Thus, the pending claims are submitted to be patentable over the Examiner's proposed combination.

Also with respect to dependent claims 21-27, since these claims are dependent from allowable independent claim 20, which is allowable for at least the reasons discussed supra, these dependent claims are also allowable for at least these reasons. Further, these dependent claims recite additional features which further define the present invention over the references of record.

Accordingly, the Examiner is respectfully requested to withdraw all rejections under 35 U.S.C. § 103 (a).

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections and an indication of the allowability of all the claims pending in the present application in due course.

SUMMARY AND CONCLUSION

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has canceled the rejected claims and has submitted new claims for consideration by the Examiner. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully requests an indication of the allowability of all the claims pending in the present application in due course.

Applicant notes that this amendment is being made to advance prosecution of the application to allowance, and with respect to the claimed features argued as deficient in the prior art, should not be considered as surrendering equivalents of the territory between the claims prior to the present amendment and the amended claims. Further, no acquiescence as to the propriety of the Examiner's rejection is made by the present amendment. All other amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

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